

DOCKET NO. 2002.01.006.WSO
U.S. SERIAL NO. 10/024,687
PATENT

REMARKS

Claims 1-36 were originally filed in the present application.

Claims 1-36 were previously cancelled.

Claims 37-68 are pending in the present application.

Claims 37-54 and 58-68 were rejected in the March 21, 2006 Office Action.

Claims 55-57 were objected to in the March 21, 2006 Office Action. The Examiner is thanked for the indication of allowable subject matter.

No claims have been allowed.

Claims 51 and 63 are amended herein to correct informalities as noted by the Examiner. Entry of these amendments is requested as they are believed to simplify matters for appeal.

Reconsideration of the claims is respectfully requested.

In Sections 2 and 3 of the March 21, 2006 Office Action, the Examiner rejected Claims 40-41, 47-48, 52-53, 59-60, 63-64, and 67-68 under 35 U.S.C. §112, second paragraph, as being indefinite for use of the phrases "second higher data rate on said second channel is greater than fourteen and one tenths kilobits per second" and "second higher data rate on said second channel is greater than seventy two kilobits per second", and similar. This rejection is traversed.

The relevant inquiry here is whether the claim as a whole apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. §112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. These limitations are absolutely clear that any data rates higher than the claimed figure would fall within the scope of the claims. Indeed, should a potential infringer manage to develop a system with an infinite data rate, he would understand clearly that this would fall within the scope of the claim.

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Numerical ranges are quite proper, as are open-ended numerical ranges. In fact, M.P.E.P. §2173.05(c) indicates that open-ended ranges are even proper when they could be construed to cover an invention that would actually be impossible to produce.

The Examiner appears to only object to the open-ended range, and does not allege that he is unable to discern the scope of the claims. As this claim language is absolutely clear and definite to one of skill in the art, the rejection is traversed.

In Sections 4 and 5 of the March 21, 2006 Office Action, the Examiner rejected Claims 37-41 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,966,384 to *Felix, et al.* (hereafter "Felix"). This rejection is traversed.

A prior art reference anticipates a claimed invention under 35 U.S.C. §102 only if every element of the claimed invention is identically shown in that single reference, arranged as they are in the claims. (*MPEP* § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. (*MPEP* § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985)).

Felix teaches transmitting data using a second channel and a second encoding scheme until an interruption in the transmission of data occurs at which point transmission continues on a first channel with a first encoding scheme. *Felix*, column 2, lines 56-60; column 3, lines 7-14; and column 3, lines 17-24. Felix discloses a controller that outputs an indication to stop transmission of data over the second channel when either: (1) all the data has been communicated to the remote unit; (2) an allotted time period has expired; or (3) the transmission has simply been interrupted. *Id.* at column 4, lines 42-58. In the first situation, Felix discloses that the remote unit will perform an

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acknowledgement of the last frames transmitted and that error control takes place when: (1) Acknowledging (ACK) packets have been received; and/or (2) Negative Acknowledgement (NAK) for messages whose sequence number has not been received even though later numbered messages have been received. *Id.* Felix in Figures 5 and 7 provides limited guidance on how data may be retransmitted in Steps 427 and 527, respectively. Steps 427 and 527 indicate that any retransmission of data occurs by transmitting the data at the first transmission rate within the first bandwidth utilizing the first spreading code modulation scheme. *Id. at Figures 5 and 7; column 8, lines 41-51; and column 9, line 62 – column 10, line 5.*

Thus, Felix fails to teach or disclose the limitations of sending at least one replacement data packet to said mobile station on a second channel at a second higher data rate; and communicating with a replacement data packet controller capable of receiving said at least one replacement data packet from said base station and incorporating said at least one replacement data packet into a data packet stream to replace one of: a missing data packet and an error data packet. Such limitations are required by independent Claim 37, as well as their respective dependent claims. The Examiner indicates that he believes that “the phrase, ‘capable of’ does not require all of the details that follow it”, and so ignores these limitations, and also ignores Claims 38-41 in their entirety. The Examiner’s belief is in error, and the Examiner cites no support for ignoring the limitations in this way. Indeed, in the present case, in contrast, “capable of” imposes a capability requirement on apparatus, *i.e.*, it must be able to receive said at least one replacement data packet and incorporating it into a data packet stream to replace a missing data packet or an error data packet.

The Examiner is invited to consider the non-precedential BPAI decision in *Ex parte Prall* (decided October 22, 2003, Appeal No. 2003-1556), which may be found at

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<http://www.uspto.gov/web/offices/dcom/bpai/decisions/fd031556.pdf>,

so that he may be fully conversant with the issues on appeal.

Nothing in Felix teaches or suggests this capability, as claimed. As such, Claim 37 distinguishes over Felix, and the anticipation rejection is traversed.

As the Examiner has improperly ignored the limitations of Claims 38-41 in their entirety, there is not even a *prima facie* anticipation rejection, and the rejection is legally deficient. The rejection of Claims 38-41 is also traversed.

In Sections 6 and 7 of the March 21, 2006 Office Action, the Examiner rejected Claims 42-48 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,277,809 to Reziifar, *et al.* (hereafter "Reziifar"). This rejection is traversed.

Claim 42 requires, among other limitations, "wherein said second base station is capable of sending said data packets to a mobile station on a second channel; wherein said first base station is capable of receiving a negative acknowledgment signal from said mobile station that said mobile station failed to correctly receive at least one data packet from said second base station; wherein said first base station and said second base station are capable of sending at least one replacement data packet to said mobile station on said second channel at a second higher data rate; and wherein said at least one replacement data packet replaces one of: a missing data packet and an error data packet."

As above, the Examiner improperly ignores the limitations of these claims that impose affirmative capability requirements on the claimed apparatus, and so fails to make even a *prima facie* anticipation rejection. The rejection is of Claims 42-48 legally deficient. The Examiner does not even attempt to show that Reziifar's system is capable of performing as claimed. The rejection of Claims 38-41 is traversed.

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In Section 8 of the March 21, 2006 Office Action, the Examiner rejected Claims 61-68 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,907,005 to *Dahlman, et al.* (hereafter "Dahlman"). This rejection is traversed.

Claim 61 requires, among other limitations, "wherein said apparatus is capable of: receiving data packets from a base station on a first channel at a first data rate; sending a negative acknowledgment signal to said base station that said mobile station failed to correctly receive at least one data packet; receiving at least one replacement data packet from said base station on a second channel at a second higher data rate; sending an acknowledgment signal to said base station that said mobile station has received said at least one replacement data packet from said base station; and wherein after sending the acknowledgment signal said apparatus is further capable of ceasing to send said at least one replacement data packet on said second channel."

As above, the Examiner improperly ignores the limitations of these claims that impose affirmative capability requirements on the claimed apparatus, and so fails to make even a *prima facie* anticipation rejection. The rejection is of Claims 61-68 legally deficient. The Examiner does not even attempt to show that Dahlman's system is capable of performing as claimed. The rejection of Claims 61-68 is traversed.

In Sections 9 and 10 of the March 21, 2006 Office Action, the Examiner rejected Claims 49-51, 54, and 57 under 35 U.S.C. §103(a) as being obvious over Felix in view of Dahlman.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re*

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Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the Applicants to produce evidence of nonobviousness. (MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the Applicants is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on the Applicants' disclosure. (MPEP § 2142).

The Examiner concedes that Felix fails to teach or suggest sending at least one replacement data packet to said mobile station on a second channel at a second higher data rate. The Examiner instead refers to Dahlman, evidently for a general teaching of high-speed downloads to a mobile terminal. Dahlman does not teach or suggest that a replacement data packet is transmitted on a

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second channel a higher data rate, nor that the "packet data applications that have high data rate/bandwidth requirements" has anything to do with replacement packets. As such, the proposed Felix/Dahlman combination still does not teach the limitations of independent Claims 49 and 54.

Further, as the Examiner should be aware, the motivation to combine or modify must be specific to the actual teachings sought to be combined. "In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention." (*Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1385 (Fed. Cir. 2001) emphasis added). "When the references are in the same field as that of the Applicants' invention, knowledge thereof is presumed. However, the test of whether it would have been obvious to select specific teachings and combine them as did the Applicants must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention." (*In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998), emphasis added).

The Examiner's stated motivation "to increase the retransmission rate while most of the mobile terminal are computer basis with Internet" [*sic*], is both incomprehensible and unrelated to the teachings sought to be combined. As such, even if the proposed combination could meet the limitations of the claims – which it does not – it is not a properly motivated combination.

The obviousness rejections of independent Claims 49 and 54, and dependent Claims 50-51 and 58 are traversed.

All rejections are traversed.

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SUMMARY

For the reasons given above, the Applicants respectfully request reconsideration and allowance of the pending claims and that this application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *jmockler@munckbutrus.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.


Respectfully submitted,

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Date:

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